

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: Peter Dam Nielsen et al. Confirmation No.: 5173
Serial No.: 10/533,245 Art Unit: 2617
Filed: April 29, 2005 Examiner: Dai Phuong
Docket Number: 915-008.034

For: COMMUNICATION APPARATUS AND A METHOD OF INDICATING
RECEIPT OF AN ELECTRONIC MESSAGE, AND A SERVER, A METHOD
AND A COMPUTER PROGRAM PRODUCT FOR PROVIDING A
COMPUTERIZED ICON ORDERING SERVICE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW
ACCOMPANIED BY NOTICE OF APPEAL

Sir:

In response to the Final Action of June 22, 2010, Applicant requests review
of the rejection prior to preparing an Appeal Brief for the following reasons:

REMARKS

In summary, the present invention claims a communication apparatus comprising a controller (800), an interface (806-850) configured to receive an electronic message (852); a display (836); and a memory (802; 804). The memory is configured to store *inter alia* at least one predefined icon for presentation on the display so as to indicate receipt of the electronic message. The memory (802-804) is configured to store an association (844, 846) between the at least one predefined icon (846) and a telephone number. The controller (800) is configured to extract the telephone number in the received electronic message, match it to a stored telephone number, and to present a matching icon, if any, on the display to indicate receipt of said received electronic message wherein the displayed matching icon is for use by a user of the apparatus to identify a sender of the electronic message according to the identification of the person stored with the telephone number, wherein the identification is not displayed with the icon. With this approach, an icon with an association to a particular sender will be displayed and indicate to the user who the sender is without unduly jeopardizing the sender's integrity or privacy because of the name and identity (such as a telephone number) of the sender are not shown on the display. See the specification at page 5, lines 8-13 corresponding to published paragraph [0014] on page 2 of US 2006/0084450. In other words, persons nearby cannot identify the sender because only the user knows the association.

The Examiner admits that the *Kamimura* reference (US 2002/0094806) does not disclose that the identification is not displayed with the icon. Rather, *Kamimura* does everything possible to put as much information about the sender on the display as possible. This would jeopardize the sender's privacy.

To negate this difference in the *Kamamura* document (that takes a completely contrary approach), and explicitly reciting applicants' own concern to prevent exposure of the sender as the motivation of one of ordinary skill to make a modification, the Examiner cites *Sim et al* (US 6,771,974). The *Sim et al* disclosure has to do with making a change to the conventional short message service (SMS) text messaging function that only provides one-way transmission of the short

message. This is viewed as disadvantageous by *Sim et al* because the message is held in a SMS server until the intended receiver is ready to get it which may be some time later. However, if the sender and receiver would rather operate in real time, the conventional SMS function does provide for two-way transmission of short messages and the sender and receiver cannot exchange short messages with each other in real time as in two-way voice communications. *Sim et al* set out to modify the SMS architecture to allow that.

The *Sim et al* reference does not at all deal with what kind of information is shown to the receiver about the identity of the sender, which of course has to take place in order to establish a communication channel in the first place. What *Sim et al* deals with is how the real-time aspects of the modification they propose to the conventional SMS function would operate.

The functionality shown in Fig. 4, to which the Examiner points, has to do with after the real-time session has already been established and therefore any screen images that might have been displayed prior to this real-time exchange of messages is not even discussed at all except implicitly, in a very general way in the flowchart of Fig. 2, where it indicates for instance at step 212 that a two-way dialogue has been selected after entering SMS mode in a step 210.

Therefore, it has to be understood that the passage cited by the Examiner at column 3, lines 52-55 has to do with how to split the screen to show both sides of the communication to both participants after the setup has already been carried out. Obviously, during the setup, there would have to be some indication on the screen of the identity of the sender as adverted to by *Sim et al* in line 55. What *Sim* is therefore showing by implication is that after the identity of the sender has been identified on the screen, it is not displayed anymore after the real-time communication commences because the receiver already knows with whom he is communicating by virtue of entering the SMS mode in the first place. In carrying out these activities it is plainly the case that *Sim et al* do not have any concern about how the identity of the sender is displayed much less preventing exposure of the sender's identity, nor is there even any hint of that.

The Applicants gave a detailed and carefully reasoned explanation of this situation in the Remarks Section of the Request for Reconsideration filed April 5, 2010 where it was also argued that the combination proposed by the Examiner of not showing identification as in the split screen of Fig. 4 of *Sim et al* is erroneous since it does not deal with identification and therefore does not hint at or suggest prevention of exposure of identity of a person to a third party and would not suggest to one of ordinary skill in the art to make a modification to the methodology shown by *Kamimura*. In the Final Rejection, the Examiner has repeated the alleged motivation to be in order to prevent the exposure of the identification of a person to a third party. But the Examiner does not explain where this motivation comes from other than the Applicants' own disclosure by way of hindsight. See lines 1 and 2 on page 7 of the Detailed Action in the Final Action of June 22, 2010. To the contrary, *Kamimura* is intent on supplying a surfeit of information (see *Kamimura*'s Figs. 2, 9 and 11) because of the difficulties mentioned in paragraphs [0006] and [0007] on page 1 and the modified SMS architecture of *Sim et al* would not give any hint or suggestion to change that.

In the "Response to Argument" Section beginning of page 2 of the Detailed Action of June 22, 2010, the Examiner merely states that it is obvious that the receiving message includes the identification of the sender of the message, without displaying the identification of the sender of the message. The reasoning in this line of argumentation is not understandable or is missing. Therefore, the obviousness rejection based on the combination of *Kamimura* and *Sim et al* is clearly erroneous because it is not based on a correct factual foundation and the analysis is faulty.

The rejections of the other independent claims are similar and are erroneous for the same reasons. The rejections of the dependent claims are erroneous for at least the same reasons.

Reconsideration and allowance is requested.

Respectfully submitted,

/Francis J. Maguire/

Francis J. Maguire
Registration No. 31,391
Attorney for the Applicant

FJM/lk
Customer No.: 10945
(203) 261-1234

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

915-008.034

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/533,245

Filed

April 29, 2010

First Named Inventor

Peter Dam Nielsen et al.

Art Unit

2617

Examiner

Dai Phuong

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Francis J. Maguire/

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Francis J. Maguire

Typed or printed name

☒ attorney or agent of record. 31,391

Registration number

203-261-1234

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

December 21, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☒ *Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.